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Erin Cowles**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appl. No. : 10/815,400 Confirmation No. 7966
Applicant : Eldridge et al.
Filed : March 31, 2004
TC/A.U. : 2829
Examiner : Ernest F. Karlsen

Docket No. : P71C2-US

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ELECTION AND TRAVERSAL OF RESTRICTION

To Whom It May Concern:

In response to the Restriction of August 14, 2006, the shortened statutory period for response to which ends on September 14, 2006, Applicants hereby elect with traverse the Invention 1, namely, claim 61.

In a restriction requirement issued August 18, 2006 (hereinafter the "Restriction"), the Examiner divided claims 47-55 and 60-67 in the above identified application into 13 groups and restricted prosecution to one group. Applicants herein traverse the Restriction and respectfully assert that the Restriction is unsupportable. Applicants therefore request that the Restriction be withdrawn.

Argument:

The Restriction should be withdrawn for at least three reasons: (1) the Restriction fails to show that the criteria for restriction stated in the Restriction were met; (2) the Restriction fails to show that the inventions are unrelated; and (3) the Restriction fails to establish burden.

A. Criteria For Restriction Stated In The Restriction Not Met

In making the Restriction, the Examiner stated that "[i]nventions are unrelated if it can be shown that they are not disclosed as capable of use together **and** they have different modes of operation, different functions or different effects." (Emphasis added) The Restriction thus correctly set forth a two element test: (1) the inventions are not disclosed as capable of use together, and (2) the inventions have different modes of operation, different functions, or different effects. (See MPEP 806.06.) The Examiner did not, however, establish that either element of the test is met for all 13 inventions identified in the Restriction. Indeed, the only support for the conclusion that the 13 inventions are allegedly unrelated provided in the Restriction was the statement that "the different inventions are each to a different combination with claims 60 and 67 being a subcombination common to all of the combinations." That statement, however, does not establish either that the 13 groups of inventions are incapable of use together or that the 13 groups of inventions have different modes of operation, functions, or effects. In fact, all dependent claims are, by definition, different combinations of the parent claim. If that mere fact were sufficient to support a restriction, then all dependent claims in all patent applications would be restrictable as drawn to independent, unrelated inventions, which is contrary to long standing practice at the PTO.

Because the Restriction thus does not establish that each of the 13 groups of inventions are unusable together and have different modes of operation, different functions, or different effects, the Restriction cannot stand. For this reason alone, the Restriction should be withdrawn.

B. The 13 groups Of inventions Are Not Unrelated

The MPEP makes clear that, to be restricted as drawn to unrelated, independent inventions, inventions must be completely unrelated—that is, entirely unusable together. Two examples given in the MPEP are a shoe and a locomotive bearing, and a process of painting a house and a process of boring a well. (MPEP § 806.04.) The MPEP also states that "[t]his situation . . . is but rarely presented, since persons will seldom file an application containing disclosures of independent things." (MPEP § 808.01.) The inventions of claims 47-55 and 60-67 are not unrelated and are in fact usable together.

For example, claim 63 (asserted invention 3) states that "the blade cuts through oxide layers formed on the terminals" and claim 64 (asserted invention 4) states that "the blades cut into the terminals." To cut into a terminal that has an oxide layer, a blade would have to cut through the oxide layer. The subject matters of claims 63 and 64 can, therefore, be used together.

As another example, a sharpened blade, as recited in claim 65 (asserted invention group 5), could undergo the deflecting motion of plus or minus thirty degrees recited in claim 61 (asserted invention 1). Accordingly, claims 61 and 65 can thus be used together.

Similar positions could be made regarding every combination of the 13 groups of invention identified in the Restriction.

C. The Restriction Did Not Establish Burden

As set forth in the MPEP, every requirement for restriction requires a showing that there "would be a serious burden on the examiner if restriction is not required." (MPEP 808.) As also set forth in the MPEP, "[f]or purposes of the initial requirement, a serious burden on the examiner may be prima facie shown by appropriate explanation of separate classification, or separate status in the art, or a different field of search." (MPEP §§ 803 and 808.02.)

Here, the Restriction does not allege the need for a separate search or that any of the 13 groups of inventions would have a different classification. Moreover, the Examiner has not provided support for the otherwise conclusory statement in the Restriction that "these inventions . . . have acquired a separate status in the art because of their recognized divergent subject matter." In fact, no evidence supports a conclusion that the 15 groups identified in the Restriction have acquired a separate status in the art or are recognized to have divergent subject matter. The Examiner has thus not established any of the three criteria necessary to show the burden element required to impose a restriction requirement.

Thus, for the additional reason that the Examiner has not established the burden element necessary to sustain the Restriction, the Restriction should be withdrawn.

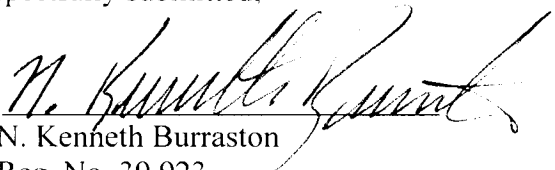
Conclusion:

For all of the above reasons, the Restriction should be withdrawn.

Respectfully submitted,

Date: September 14, 2006

By


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